

REMARKS

Claim 8 is amended to delete "acetylated derivatives thereof". Support is found in the Specification at, for example, page 9, lines 3-7; and in original claim 8. *See In re Gardner*, 177 USPQ 396, 397 (CCPA 1973); and MPEP §§ 608.01(o) and (l).

Indefiniteness Rejection

Claim 8 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. (Paper No. 20080622 at 2.)

In making the rejection, the Examiner asserted that the "claim recites 'acetylated derivatives thereof', which is vague and indefinite because the expression fails to state the derivatives of what is being claimed." (Id. at 3.)

To forward prosecution in this application, claim 8 has been amended to delete "acetylated derivatives thereof". It is submitted that the rejection is rendered moot.

In view of the foregoing, reconsideration and withdrawal of the rejection is requested.

Obviousness Rejection

A. Chen

Claims 1, 3, 10-15 and 17 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,162,474 to Chen et al. ("Chen"). (Id.)

In making the rejection, the Examiner noted that "[t]he applied reference has a common inventor with the instant application." (Id.) In addition, the Examiner

asserted that “[b]ased upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e).” (Id.)

The Examiner listed various possible ways in which the rejection may be overcome, including “by showing that the reference is disqualified under 35 U.S.C. § 103(c) as prior art in a rejection under 35 U.S.C. § 103(a).” (Id. at 3-4.)

The Examiner asserted that “Chen teaches a powder composition that comprises droplets of a fat soluble vitamin where the droplets of vitamin average about 70-200 nm and dispersed in a polysaccharide matrix and methods of making tablets. Chen teaches all of the vitamins of the instant claims 10-11 (col. 1-2, summary of the invention and col. 6). With respect to the amount, Chen teaches 0.5% to 75%, which encompasses the claimed 10% to 30%. Further, Chen teaches the ratio of vitamin to polysaccharide and the amount of polysaccharide in col. 6. Chen does not teach the exact ratio of 10[%] to 30% for vitamin droplet. However, Chen teaches various ranges of percentages such as 7.5% to 20%, 15% to 40%, where the composition may contain only vitamin and polysaccharide in the emulsion (see col. 6).” (Id. at 4.)

The Examiner concluded that “it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to optimize the amount of vitamin in preparing the powder composition of Chen, depending on the vitamin employed or the amount desired in the composition.” (Id.)

We submit that Chen is disqualified as a reference under 35 U.S.C. § 103(c)(1) as prior art in a rejection under 35 U.S.C. § 103(a) because the subject matter of Chen and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. The inventors of the present application, Chyi-Cheng Chen and Bruno

Leuenberger, had an obligation to assign the present application to F. Hoffmann-La Roche AG, as evidenced by the Assignment executed on November 20, 2000, which is attached as Exhibit A. On November 21, 2000, the present application was assigned by F. Hoffmann-La Roche AG to Roche Vitamins Inc. This Assignment is attached as Exhibit B. The present application was subsequently assigned to DSM Nutritional Products, Inc. in 2003.

The inventors of the application which matured into the Chen patent, Chyi-Cheng Chen, William Joseph Mergens, and Mark Cordes Milbank, had an obligation to assign to Roche Vitamins Inc., as evidenced by the Assignment executed on June 23, 1998, which is attached as Exhibit C. In 2003, the rights were assigned from Roche Vitamins Inc. to DSM Nutritional Products, Inc. Thus, the present application and Chen are now commonly owned.

Upon information and belief, during 1998-2000, both affiliates, F. Hoffmann-La Roche AG and Roche Vitamins, Inc., were under the common control of Roche Holding AG, and at such time period when the invention was made, the applications were owned by the same entity or there was an obligation to assign to the same entity. In view of the foregoing, it is submitted that the rejection has been rendered moot.

Withdrawal of the rejection is requested.

B. Chen in view of EP '412

Claims 3-6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen as applied to claims 1, 3, 10-15 and 17 in the previous rejection, and further in view of EP 937412 to Stein, et al. ("EP '412"). (Id. at 4.)

In making the rejection, the Examiner asserted that "Chen, discussed above, teach polysaccharide matrix for the preparation of spray dried tablets." (Id.)

The Examiner acknowledged, however, that "Chen does not teach the claimed polysaccharides of the instant gums." (Id.)

The Examiner asserted that "EP '412 teaches finely divided pulverous carotenoids [sic] preparations formed by suspending the active ingredient in an organic solvent, feeding the suspension to a heat exchanger, [and] rapidly mixing with a swellable colloid. EP teaches the particle size such as 213 nm, 225 nm or 400 nm. Among the colloids, EP teaches gelatin, starch, gums, pectin etc (col. 3, L 1-7)." (Id. at 5.)

The Examiner concluded that "[i]t would have been obvious for one of an [sic] ordinary skill in the art at the time of the instant invention to prepare the powders of Chen by incorporating colloids such as polysaccharide gums such as those taught by EP because EP suggests colloids such as gelatin and gums as equivalent in preparing vitamin powder preparations. Accordingly, absent any unexpected advantage, it would have been within the scope of a skilled artisan to optimize the amounts of vitamins and colloids, based on the colloid employed, so as to prepare vitamin powder preparations with the claimed particle sizes." (Id.)

We incorporate the arguments presented in section A above. Accordingly, it is submitted that Chen is disqualified under 35 U.S.C. § 103(c)(1) for use in a rejection under 35 U.S.C. § 103(a) because, upon information and belief, the subject matter of Chen and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Without Chen as the Examiner's primary document, the rejection must fall. Withdrawal of the rejection is requested.

C. Chen in view of Berneis

Claims 7-9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,162,474 to Chen as applied to claims 1, 3, 10-15 and 17 in the previous rejection, and further in view of US 5,478,569 to Berneis et al. ("Berneis"). (Id.)

In making the rejection, the Examiner acknowledges that "Chen does not teach the claimed protein matrix for preparing the powder." (Id.)

The Examiner asserted that "Bernesi [sic] teaches fat soluble pulverous composition of colloidal fish gelatin as the protective colloid (col. 1, L 50-67). The vitamins described by Bernesi [sic] are the same as that of Chen and instant claims. Chen teaches that the vitamins are enveloped by the protective colloid for stabilization for optimal resorption and stabilization (col. 2). The method of preparing the powder in Bernesi and Chen are similar (col. 2 -3 and examples). Bernesi [sic] further states that in addition to gelatin, the preparation can have other adjuvant such as starch, proteins etc (col. 2). Thus, Bernesi [sic] teaches a combination of starches (or other proteins) and fish gelatin for stabilizing the fat soluble substances." (Id. at 5-6.)

The Examiner concluded that "it would have been obvious for one of an ordinary skill in the art at the time of the instant invention was made to employ fish gelatin as a matrix in preparing fat soluble powders of Chen because Bernesi [sic] teaches both gelatin and starches are effective in stabilizing and teaches gelatin for stabilizing and resorption of the fat soluble substances." (Id. at 6.)

We incorporate the arguments presented in section A above. Accordingly, it is submitted that Chen is disqualified under 35 U.S.C. § 103(c)(1) for use in a rejection under 35 U.S.C. § 103(a) because, upon information and belief, the subject matter of Chen and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Without Chen as the Examiner's primary document, the rejection must fall. Withdrawal of the rejection is requested.

Double Patenting

Claims 1, 3-15 and 17 were rejected under the judicially created doctrine of double patenting rejection as being unpatentable over the claims 1-20 of Chen.

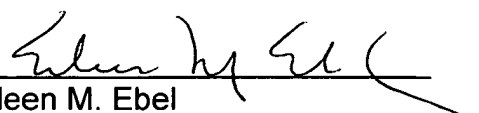
Until allowability is determined, requiring a Terminal Disclaimer is premature. MPEP § 1490. Upon notification of allowability of the application but for the double patenting rejection, a Terminal Disclaimer may be submitted.

For the reasons set forth above, withdrawal of the rejections and allowance of the claims are respectfully requested. If the Examiner has any questions regarding this paper, please contact the undersigned.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on December 24, 2008.


Eileen M. Ebel, Reg. No. 37, 316

Respectfully submitted,

By: 
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Assignment

WHEREAS, I/WE

Chyi-Cheng Chen, Bruno Leuenberger

the ASSIGNOR(S), have invented certain new and useful improvements in

A VITAMIN POWDER COMPOSITION AND METHOD OF MAKING

which are described and claimed in application for United States Letters Patent in respect of which a Declaration and Power of Attorney was executed on

November 20, 2000

which application is based upon the following foreign application(s)

in Europe on December 9, 1999 under No. 99124519.2

NOW, THEREFOR, for and in consideration of the sum of One Dollar (\$1.00) and other good and valuable considerations to me (us) in hand paid, the receipt and sufficiency whereof are hereby acknowledged, I/we have sold, assigned and set over, and by these presents do hereby sell, assign and set over unto


**F. Hoffmann-La Roche AG, a Swiss Company
of 124 Grenzacherstrasse, CH-4070 Basle (Switzerland) the Assignee**

and the said Assignee's legal representatives, successors and assigns, the entire right, title and interest, in and to the said invention within the United States of America and its territories and possessions, and in and to said application and the Letters Patent of the United States of America that may be granted therefor, together with the right to extend the protection thereof to the various territories and possessions now owned or which may be acquired hereafter by the United States of America; and I/we do hereby request and authorize the Commissioner of Patents to issue said Letters Patent to the above-mentioned Assignee agreeably with the terms of this assignment.

UPON SAID CONSIDERATION, I/we do hereby covenant and agree with the said Assignee that I/we will not execute any writing or do any act whatsoever conflicting with these presents, and that I/we will at any time upon request without further or additional consideration, but at the expense of the said Assignee, execute such additional assignments and other writings and do such additional acts as said Assignee may deem necessary or desirable to perfect the Assignee's enjoyment of this grant, and render all necessary assistance in making application for and obtaining original, divisional, reissued, or extended Letters Patent of the United States of America on said invention, and in enforcing any rights or choses in action accruing as a result of such applications or patents, including but not limited to, giving testimony in any proceedings or transactions involving such applications or patents, and executing preliminary statements and other affidavits, it being understood that the foregoing covenant and agreement shall bind and inure to the benefit of the assigns and legal representatives of all parties hereto.

IN WITNESS WHEREOF, this Assignment has been executed by the Assignor(s) at Basle, Switzerland, on
November 20, 2000.


Chyi-Cheng Chen


Bruno Leuenberger

Assignment

We,

F. Hoffmann-La Roche AG (Assignor), a Swiss Company
of 124 Grenzacherstrasse, CH-4070 Basle (Switzerland)

hereby assign to

ROCHE VITAMINS INC. (Assignee)

a corporation organized and existing under and by virtue of the laws of the State of Delaware, and having its principal place of business at 43 Waterview Blvd., Parsipanny, New Jersey, U.S.A.,

all of our right, title and interest within the United States of America and its territorial possessions in and to the invention described and claimed in a patent application entitled

A VITAMIN POWDER COMPOSITION AND METHOD OF MAKING

which is about to be filed in the U.S. Patent Office in the name(s) of the inventor(s)

Chyi-Cheng Chen, Bruno Leuenberger

and in respect of which a declaration and Power of Attorney was executed on:

November 20, 2000

and in and to said patent application and Letters Patent that may issue thereon.


Said U.S. Patent Application is based upon the following foreign application(s):

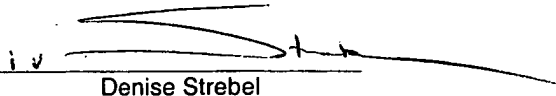
in Europe on December 9, 1999 under No. 99124519.2

and was assigned to F. Hoffmann-La Roche AG, Basle, Switzerland, by the said inventor(s) by an assignment dated November 20, 2000.

Basle, Switzerland, this 21st day of November 2000.

F. Hoffmann-La Roche AG


Fridolin Klausner
Holder of procuration


Denise Strebel
Mandatory

ASSIGNMENT

WHEREAS, WE, Chyi-Cheng Chen, William Joseph Mergens, Mark Cordes Milbank (Assignors) have invented certain new and useful improvements which are described and claimed in application for United States Patent and identified as Case Docket No. 1069P, entitled

VITAMIN POWDERS FOR BEVERAGE APPLICATIONS

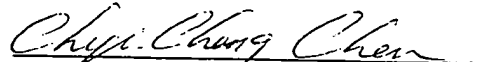
WHEREAS, ROCHE VITAMINS INC., a corporation organized and existing under and by virtue of the laws of the State of Delaware, and having its principal place of business at Parsippany, New Jersey, is desirous of acquiring the entire interest in and to said invention, said application and the Patent to be obtained therefor;

NOW, THEREFORE, for and in consideration of One Dollar (\$1.00) and other good and valuable consideration to us in hand paid, the receipt and sufficiency whereof are hereby acknowledged, we have sold, assigned, and set over, and by these presents do hereby sell, assign, and set over unto the said ROCHE VITAMINS INC. (Assignee), and said Assignee's legal representatives, successors, the entire right, title and interest, for the whole world, in and to said invention and said application, as well as any subsequent application which claims priority based upon the filing date of said application identified as Case Docket No. 1069P and the patents, both domestic and foreign, that may or shall result therefrom including the right to claim in respect of any subsequent United States and foreign patent applications and patents, the priority date of said application under any United States statute and international convention or treaty; and we do hereby authorize and request the issuance of said patents, domestic and foreign, conformably to the terms of this Agreement.

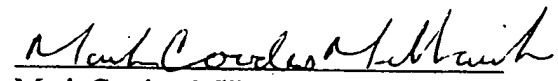
UPON SAID CONSIDERATION, we do hereby covenant and agree with the said Assignee that we will not execute any writing or do any act whatsoever conflicting with these presents, and that we will at any time upon request, without further or additional consideration, but at the expense of the said Assignee, execute such additional assignments and other writings and do such additional acts as said Assignee may deem necessary or desirable to perfect the Assignee's enjoyment of this grant, and render all necessary assistance in making application for and obtaining provisional, original, continuation, continuation-in-part, divisional, reissued, re-examined or extended Patent of the United States or of any and all foreign countries on said invention, and in enforcing any rights or choses in action accruing as a result of such applications or patents, including but not limited to, giving testimony in any proceedings or transactions involving such applications or patents, and executing preliminary statements and other affidavits, it being understood that the foregoing covenant and agreement shall bind and inure to the benefit of the assigns and legal representatives of all parties hereto.

IN WITNESS WHEREOF, we have hereunto set our hands and affixed our seals this 23rd day of June, 1998.

Nutley, New Jersey, U.S.A.


Chyi-Cheng Chen

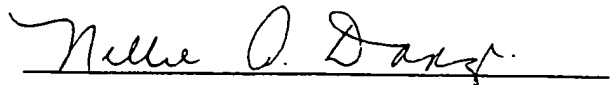

William Joseph Mergens


Mark Cordes Milbank

ACKNOWLEDGMENT

United States of America)
State of New Jersey)
County of Essex)

On June 23, 1998, before me personally appeared Chyi-Cheng Chen, William Joseph Mergens and Mark Cordes Milbank to me known to be the persons described in the foregoing Assignment, who acknowledged that they executed the foregoing Assignment of their own free will for the purposes therein set forth.



NELLIE A. DANZI
Notary Public of New Jersey
My Commission Expires July 22, 2000

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